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REPORT ON THE

FILING OR DETERMINATION OF AN  
ACTION REGARDING A PATENT OR  
TRADEMARK

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been  
filed in the U.S. District Court Northern District of California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 08-03667 RS	DATE FILED 7/31/2008	U.S. DISTRICT COURT 280 South First St, Rm 2112, San Jose, CA 95113
PLAINTIFF SILICONWARE PRECISION INDUSTRIES CO.		DEFENDANT TESSERA INC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 5,663,106		SEE ATTACHED COMPLAINT
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK Richard W. Wieking	(BY) DEPUTY CLERK Betty Walton	DATE August 5, 2008
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner  
Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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SILICONWARE PRECISION INDUSTRIES CO., LTD.  
8 and SILICONWARE U.S.A., INC.

9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA

CV 08

3667

12 SILICONWARE PRECISION INDUSTRIES  
13 CO., LTD. AND SILICONWARE U.S.A.,  
INC.

14 Plaintiffs,

15 v.

16 TESSERA, INC.,

17 Defendant.

Case No.

**COMPLAINT FOR DECLARATORY  
JUDGMENT OF NON-  
INFRINGEMENT, INVALIDITY  
AND UNENFORCEABILITY OF U.S.  
PATENT NO. 5,663,106**

**DEMAND FOR JURY TRIAL**

**COMPLAINT**

Plaintiffs Siliconware Precision Industries Co., Ltd. and Siliconware USA Inc. (collectively "Siliconware") for its Complaint against Tessera Inc. herein allege:

**NATURE OF ACTION**

1. This is an action for declaratory relief arising under the Patent Act of the United States, 35 U.S.C. § 271 et seq. regarding non-infringement, invalidity and unenforceability of United States Patent Nos. 5,663,106 ("106 patent"). A copy of the '106 patent is attached hereto as Exhibit A.

**PARTIES**

2. Siliconware Precision Industries Co., Ltd. is a corporation organized under the laws of the Republic of China, having its principal place of business at No. 123, Sec. 3 Da Fong Road, Tantz, Taiwan, ROC.

3. Siliconware USA Inc. is a California corporation have a place of business at 1735 Technology Drive #300, San Jose California 95110.

4. On information and belief, Tessera Inc. is a Delaware corporation with its principal place of business in San Jose, California.

**JURISDICTION**

5. This Court has jurisdiction over this action, under 28 U.S.C. §§ 1338(a), 2201, and 2202, because this action arises under the patent laws of the United States, and is based upon an actual controversy between Siliconware and Tessera regarding the non-infringement, invalidity and unenforceability of the '106 patent.

**VENUE**

6. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c). A substantial part of the facts giving rise to the claims asserted herein occurred in this district, in that Siliconware has been accused of patent infringement for products that are offered for sale in this district. This district is also the principal place of business for Siliconware USA Inc. Furthermore, Tessera has made a specific and definite assertion of patent infringement within this District by and through a telephone call to Siliconware's attorneys.

7. Personal jurisdiction and venue over Tessera is proper in this District as Tessera markets and licenses its patent portfolio within this jurisdiction and has conceded jurisdiction in concurrent litigation pending before Judge Wilken. Tessera's headquarters is also in this District.

#### **FACTUAL BACKGROUND**

8. On September 2, 1997, the United States Patent Office issued the '106 patent and is entitled "Method of Encapsulating Die and Chip Carrier." The '106 patent states on its face that Tessera is its assignee. Exhibit A, page 1.

9. On July 30, 2008, Tessera informed Siliconware that Tessera intends to move to add the '106 patent to the pending International Trade Commission Investigation entitled *In the Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same (IV), ITC Inv. No. 337-TA-64* ("the 649 Investigation"), alleging that some of Siliconware's packaging services infringe the '106 patent.

10. The parties have an acrimonious history. At present, the parties are involved in two separate patent cases: the 649 Investigation and a pending patent infringement case in United States District Court in the Northern District of California, Case. No. 05-4063 CW, before the Honorable Claudia Wilken. Each case has multiple Patents in Suit and concern products similar to those products which Tessera contends infringe the '106 patent.

11. By reason of the foregoing, Siliconware has a reasonable apprehension that Tessera will file an action against Siliconware for infringement of the '106 patent.

12. Siliconware therefore seeks a Declaratory Judgment from this Court that Siliconware's packaging services do not infringe Tessera's '106 patent.

13. Siliconware also seeks a Declaratory Judgment from this Court that Tessera's '106 patent is invalid as being anticipated and/or obvious under the prior art as the accused technology existed more than one year before the application for the '106 patent was filed.

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**FIRST CLAIM FOR RELIEF**

14. Plaintiff Siliconware realleges and repeats the allegations of paragraphs 1-13 as through fully set forth herein.

15. Therefore, Siliconware seeks a declaration that Siliconware has not infringed the '106 patent by making, using, offering to sell, selling, or importing any product in or into the United States and that no claim of the '106 patent may be interpreted to encompass any Siliconware process that either literally or under the doctrine of equivalents.

16. Siliconware seeks a Declaratory Judgment from this Court, under Fed. R. Civ. P. 57 and 28 U.S.C. §§ 2201 and 2202, declaring the '106 patent to be not infringed by Siliconware, and granting Siliconware all other declaratory relief to which it may be entitled.

**SECOND CLAIM FOR RELIEF**

17. Plaintiff Siliconware realleges and repeats the allegations in paragraphs 1-16 as through fully set forth herein.

18. Siliconware therefore seeks a Declaratory Judgment from this Court, under Fed. Civ. P. 57 and 28 U.S.C. § 2201, declaring that claims of the '106 patent are invalid.

**PRAYER FOR RELIEF**

WHEREFORE, Siliconware, respectfully requests that the Court:

A. Judicial Declaration that:

1. Siliconware Precision Industries Co., Ltd. and Siliconware USA Inc. have not infringed and is not infringing any claim of Tessera's United States Patent No. 5,663,106 by making, using, selling, offering to sell, or importing any products.

2. The claims of Tessera's United States Patent No. 5,663,106 are invalid;

B. Any and all equitable relief to which Siliconware Precision Industries Co., Ltd. and Siliconware USA Inc. are entitled;

C. Siliconware Precision Industries Co., Ltd. and Siliconware USA Inc. be awarded all other and further relief to which they may be entitled; and


D. The Court order such relief as the Court deems just and equitable.

JURY DEMAND

Siliconware Precision Industries Co., Ltd. and Siliconware USA Inc. demand a trial by jury of all issues triable of right by a jury.

Dated: July 31, 2008

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